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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

CAMPBELL, JOSHUA D

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/862,448
Filing Date: May 23, 2001
Appellant(s): IWATA ET AL.

Luminita A. Todor
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 19, 2008 appealing from the Office action mailed June 13, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: The ground of rejection to be reviewed on appeal is the rejection of claims 1, 5-13, and 17-27 under 35 U.S.C. 103(a) as being unpatentable over Endo et al. in view of Palmer et al.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,801,713	ENDO et al.	9-1998
6,002,798	PALMER et al	12-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 5-13, and 17-23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Endo et al. (hereinafter Endo, US Patent Number 5,801,713, issued on September 1, 1998) as applied to claims 1 and 13 above, and further in view of Palmer et al. (hereinafter Palmer, US Patent Number 6,002,798, issued on December 14, 1999).

Regarding independent claim 1, Endo discloses a method in which a document made up of pages is displayed to user to be read (column 4, lines 6-47 of Endo). Endo discloses that a user may control the display state of the displaying section (column 4, lines 6-47 of Endo). Endo also discloses a method in which each page may displayed as a whole or an automatic paging sequence that may be set to different speeds will automatically scroll the pages in succession based a display speed (column 2, line 42-column 3, line 50 of Endo). Endo discloses the ability for the user to select from the basic read mode and a plurality of automatic paging modes, this control ultimately

controlling what is displayed and how it is controlled (column 3, line 29-column 4, line 63 of Endo). Endo discloses a method in which the document may be scrolled in at least two modes; A1 (cursory mode) which would allow for a user to read the page and view the outlines and A2 (general view mode) which is faster and would simply allow the user to get a good look at the page as a whole (Figures 3 and 4 and column 5, lines 15-25 of Endo).

Endo does not disclose a method in which only the titles and emphasized parts, which could be detected according to a predetermined condition such as font type and size, or only a layout-display are displayed from each page of the document during the viewing of the document. However, Palmer discloses a method in which a document display program will only extract and display the title of documents and a document element according to font type or size or the layout (structure) of documents based on the users preferences (Figure 6 and column 6, line 37-column 8, line 63 of Palmer). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Endo with the methods of Palmer because it would have allowed for rapid browsing of documents.

Regarding dependent claims 5-7, Endo does not disclose a method in which only the title, a layout-display, document element according to a predetermined condition such as font type and size, and that only an image would be extracted from each page of the document for display. However, Palmer discloses a method in which a document display program will only extract and display the title of documents, the layout of documents, a document element according to font type or size, or an image

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contained in documents based on the users preferences (Figure 6 and column 6, line 37-column 8, line 63 of Palmer). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Endo with the methods of Palmer because it would have allowed for rapid browsing of documents.

Regarding dependent claim 8, Endo does not disclose a method in which a page is displayed schematically by changing the display resolution. However, Palmer discloses a method in which changing the display resolution allows for more rapid viewing of a document with loss of quality, allowing a user to view the document as a schematic rather than a highest quality (column 1, line 30-column 2, line 54 of Palmer). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Endo with the methods of Palmer because it would have allowed for rapid browsing of documents.

Regarding dependent claims 9 and 10, Endo discloses a method in which the speed at which the pages are scrolled may be set in each mode (column 3, line 29-column 4, line 63 of Endo). Endo does not disclose that each display method is established in each mode. However, Palmer discloses a method in which each display method may be individually established for the document viewing process (column 6, line 37-column 8, line 63 of Palmer). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Endo with the methods of Palmer because it would have allowed for rapid browsing of documents.

Regarding dependent claims 11 and 12, Endo discloses a method in which in which different modes may be selected and the paging display mode is based on the selections (column 3, line 29-column 4, line 63 of Endo). Endo does not disclose that the selection process consists of switches. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of Endo with a method of using switches because it was well known in the art at the time of the invention that a selection process as disclosed by Endo consists of a set of logic that is determined based on selections which could be thought of as virtual switches.

Regarding independent claim 13, the claim incorporates substantially similar subject matter as claim 1. Thus, the claim is rejected along the same rationale as claim 1.

Regarding dependent claims 17-20, the claims incorporate substantially similar subject matter as claims 5-8. Thus, the claims are rejected along the same rationale as claims 4-8.

Regarding independent claim 21, Endo discloses a method in which a document made up of pages is displayed to user to be read (column 4, lines 6-47 of Endo). Endo discloses that a user may control the display state of the displaying section (column 4, lines 6-47 of Endo). Endo also discloses a method in which each page may displayed as a whole or an automatic paging sequence that may be set to different speeds will automatically scroll the pages in succession based a display speed (column 2, line 42-column 3, line 50 of Endo). Endo discloses the ability for the user to select from the basic read mode and a plurality of automatic paging modes, this control

ultimately controlling what is displayed and how it is controlled (column 3, line 29-column 4, line 63 of Endo). Endo discloses a method in which the document may be scrolled in at least two modes; A1 (cursory mode) which would allow for a user to read the page and view the outlines and A2 (general view mode) which is faster and would simply allow the user to get a good look at the page as a whole (Figures 3 and 4 and column 5, lines 15-25 of Endo).

Endo does not disclose a method in which only the titles and emphasized parts, which could be detected according to a predetermined condition such as font type and size, or only a layout-display are displayed from each page of the document during the viewing of the document. However, Palmer discloses a method in which a document display program will only extract and display the title of documents and a document element according to font type or size or the layout (structure) of documents based on the users preferences (Figure 6 and column 6, line 37-column 8, line 63 of Palmer). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Endo with the methods of Palmer because it would have allowed for rapid browsing of documents.

Regarding dependent claim 22, Endo does not disclose a method in which only the title, a layout-display, document element according to a predetermined condition such as font type and size, and that only an image would be extracted from each page of the document for display. However, Palmer discloses a method in which a document display program will only extract and display the title of documents, the layout of documents, a document element according to font type or size, or an image contained

in documents based on the users preferences (Figure 6 and column 6, line 37-column 8, line 63 of Palmer). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Endo with the methods of Palmer because it would have allowed for rapid browsing of documents.

Regarding dependent claim 23, Endo discloses that the time interval for paging may be changed by the user at any time (column 6, lines 17-23 of Endo).

(10) Response to Argument

Regarding appellant's arguments found on pages 5 and 6, in reference to the limitations in independent claims 1 and 13 which state, "...a partially displaying mode in which a portion of each page is displayed, the displaying portion being extracted according to a predetermined condition," the examiner respectfully disagrees and maintains that the rejection is proper. The appellant argues, "...Palmer's different levels of abstraction according to which documents are always displayed within the structural view of the whole page, do not anticipate or render obvious..." the limitation in question. It appears that the appellant's stance on the limitation in question is that the "portion" disclosed is a portion of the physical page itself, however this is incorrect. The appellant's specification clearly states that the portions that are extracted for the purposes of display are portions of content (page 12, line 21-page 13 ,line 1 of appellant's specification). That portion of the specification actually explicitly states that a partial display of the page is actually "(the contents of the page)" not the physical structure of the page, the specification goes on to give an example of displaying only the title portion or emphasized portions "of the document contents," which again

disagrees with the appellant's argument about how the term "portion" should be interpreted. The same statements about what a portion actually is can also be found again in the specification, on page 61, lines 5-13 of appellant's specification. The examiner's position with regard to the interpretation of the term "portion" can be better understood by looking at Figure 14 of appellant's specification, as can be seen the physical page itself is not in any way portioned off, rather the whole page is displayed but the only portions of the content are displayed exactly where they would have appeared in the document if it were displayed wholly. The examiner relied on the Palmer reference to properly teach this limitation as being obvious. Palmer discloses a method in which a document display program will only extract and display the title of documents and/or document elements according to retrieval parameters of documents based on the users preferences (Figure 6 and column 6, line 37-column 8, line 63 of Palmer). The Palmer reference states specific embodiment including nine abstraction levels, which the examiner based the rejection on, however Palmer explicitly states that "...other arrangements are possible:" (column 8, lines 29-41 and Figures 8-10 of Palmer). As can be seen by the teachings of Palmer only a portion of the contents of the document are displayed in the partial display modes, which clearly corresponds to the proper broadest most reasonable interpretation of the limitation in question in view of the appellant's specification regardless of whether or not structure is also shown, because the structure of the document and the contents are two separate entities as defined by both the appellant's specification and the Palmer reference.

Regarding appellant's arguments found on pages 5, in reference to the limitations of claims 5 and 6 which state that the predetermined condition involves a font size and/or font type, the examiner respectfully disagrees and maintains that the rejection is proper. The Palmer reference teaches that a document can be broken down into regions, those regions have a type and those types have region attributes that include a font size and font type (Figure 6 and column 7, lines 41-44 of Palmer). Both the limitations in claims 5 and 6 merely require that the predetermined condition "involves" font type and/or size. In the teachings of Palmer, the basic levels of abstraction are based on region type (i.e. Titles), and the regions have a corresponding font size and font type, thus when a specific region type is the predetermined condition for partial display it clearly involves a font type and font size. For instance, if the user selects to display Titles (Level 2), the predetermined condition will dictate the display of all contents with Roman 15pt font, but when the user dictates displaying Full Text (Level 5) the predetermined condition will dictate the display of all contents Roman 8pt font and up (including the titles with Roman 15pt font) (column 8, lines 29-41 and Figures 8-10 of Palmer), which clearly "involves" font type and size. Thus, the rejection of these claims is proper and has been maintained.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Endo for automatically paging the documents with the methods of Palmer because it would have allowed for rapid browsing of documents by displaying abstract views of the document, which is clearly supported in column 2, lines 34-39 of Palmer. Thus, the rejection of these claims is proper and has been maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Joshua D Campbell/

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Conferees:

Stephen Hong, Supervisory Patent Examiner for Group Art Unit 2178

Doug Hutton, Supervisory Patent Examiner for Group Art Unit 2176